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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,739

09/30/2003

William T. Ball

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12/19/2005

ZARLEY LAW FIRM P.L.C.

CAPITAL SQUARE

400 LOCUST, SUITE 200

DES MOINES, IA 50309-2350

EXAMINER

FETSUGA, ROBERT M

ART UNIT

PAPER NUMBER

3751

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/674,739	Applicant(s) BALL, WILLIAM T.	
	Examiner Robert M. Fetsuga	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 120 is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/247,247, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Claims 1 and 2 of the instant application recite a drain pipe/overflow pipe. This element, designated as reference numeral "34" in Fig. 1A filed September 30, 2003, is not found in the 10/247,247 application.

2. The proposed drawing correction filed on October 17, 2005 is disapproved as containing new matter. The feature referred

to by reference numeral "34" in Fig. 1A is not supported by the originally filed disclosure.

Applicant argues at page 6 of the response filed October 17, 2005 an L-shaped drain pipe was originally shown in Fig. 3. The examiner does not disagree, however, element 34 illustrated in Fig. 1A is not L-shaped, and this feature appears to be the substance of lines 4-6 in claim 1.

3. The amendment filed October 17, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Reference at page 3, lines 27-28, to an "inverted L-shape". Claim 1 also recites this new matter. Element 34 illustrated in the drawings filed September 30, 2003 does not exhibit such a shape.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The drawings are objected to because reference numerals "35A", "35B" and "39" (pg. 3 lns. 28, 29 and 35) are missing, and reference numerals "51" and "63A" (pg. 4 lns. 6 and 8) are missing.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "inverted L-shape" set forth in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

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corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The disclosure is objected to because of the following informalities: Page 4, line 16, "34" apparently should be --39--.

Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis for the "overflow system" and "drain pipe" (lns. 4-6) set forth in claim 1, and "plumbing test system", "threaded portion", "solid cap" and "portion" (ln. 6) set forth in claim 2, could not be found in the specification. Applicant is reminded claim terminology in mechanical cases should appear in the descriptive portion of the specification by reference to the drawing(s).

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is unclear as to whether the "bathtub" is intended to be part of the claimed combination since structure of the "overflow system" is defined as being connected thereto

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(ln. 7), but no positive structural antecedent basis therefor has been defined.

8. The claim hierarchy does not appear to be in accordance with MPEP 608.01(m). Claims remaining at allowance may require renumbering.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 2, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Mathison.

The Mathison reference discloses a plumbing test system (title) comprising: an overflow/drain pipe (Fig. 6); and a threaded (Figs. 1 and 3) solid cap/plug (Figs. 5 and 6), as claimed.

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11. Claims 1 and 2, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor, Jr. et al., Mathison and applicant's admitted prior art.

The Taylor, Jr. et al. (Taylor) reference (col. 1) discloses the conventional practice of utilizing a plug to seal an overflow opening in a bathtub to enable pressure testing of the drain/overflow system. Therefore, Taylor teaches all claimed elements except for the plug being threaded.

Although the test plug of the Taylor drain/overflow system may not be threaded, as claimed, attention is directed to the Mathison reference which discloses an analogous drain/overflow system (Fig. 6) which further includes a threaded test plug (Figs. 1, 3 and 5). Therefore, in consideration of Mathison, it would have been obvious to one of ordinary skill in the drain/overflow system art to associate threads with the Taylor test plug in order to utilize an easily manipulated plug. Furthermore, even though the illustrated overflow port of the Mathison conventional drain/overflow system is not illustrated as being threaded, it would appear, logically, that threads are associated therewith to receive the threaded plug. In any event, such a threaded overflow system is conventional as acknowledged as prior art at page 3 of the instant application.

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12. Applicant's remaining remarks have been fully considered and either have been previously addressed or are not deemed persuasive in view of the newly applied prior art.

13. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

14. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.

A handwritten signature in black ink, appearing to read "Robert M. Fetsuga", is positioned above the printed name.

Robert M. Fetsuga
Primary Examiner
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